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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/908,950

07/19/2001

Robert C. Getts

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1927

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09/11/2009

Morris E. Cohen
1 Penn Plaza, Suite 2527
New York, NY 10119

EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT

PAPER NUMBER

1637

MAIL DATE

DELIVERY MODE

09/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/908,950	Applicant(s) GETTS ET AL.	
	Examiner Suryaprabha Chunduru	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Upon reconsidering the petition decision issued on August 25, 2009 to revive the application, the application is reopened for examination.

Status of the application

2. Currently claims 1-58 are pending. All arguments and amendment have been fully considered and thoroughly reviewed and deemed unpersuasive for the reasons that follow.

Response to Arguments:

3. With regard to the rejection of claims 1-3, 7-8, 17, 18-22, 25-26, 35-58 under 35 USC 103(a) as being unpatentable over Skouv in view of Gerhart et al., Applicants' arguments were fully considered and found unpersuasive. Applicants argue that the Skouv reference does not teach RNA comprising a capture sequence and a target sequence as claimed in the instant invention. The arguments were found unpersuasive because the cited columns in the rejection teach the use of mRNA and mRNA inherently comprises a polyA capture sequence and a target sequence of interest. The instant dependent claims recite capture sequence as polyA sequence. col. 7, line 1-10, clearly indicate that the target sequence is hybridized to a signal nucleic acid that is different from the capturing probe that hybridizes to a different portion of the RNA, which clearly indicate that RNA comprises a capture sequence and a target sequence. Applicants also argue that the capturing nucleic acids are immobilized in Skouv reference which is analogous to the instant claimed invention. The arguments were found unpersuasive. As discussed in the rejection, the capture nucleic acid probes are immobilized to an array to which the RNA sample is hybridized (see col. 5, line 27-39).

With regard to the arguments based on the hindsight reconstruction of the invention, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case as discussed in the rejection one skilled in the art would know that RNA or mRNA comprises polyA capture sequence and a target sequence as taught by Skouv and it is obvious to modify the method of determining the presence of a specific sequence in RNA of a target sample as taught by Skouv in a manner taught by Gerhart et al. as discussed in the rejection. Accordingly the rejection is maintained.

4. With regard to the rejection of claims 4-6, 9-16, 23-24, 27-34 under 35 USC 103(a) as being unpatentable over Skouv in view of Gerhart et al. and further in view of Van Ness, Applicants' arguments were found unpersuasive. As discussed above Skouv does teach RNA component comprising a capture sequence and a target sequence and as discussed in the rejection it would be obvious to modify the method with the teachings of Van Ness and accordingly the rejection is maintained.

5. With regard to the rejection of claims 1-5, 9-17, 19-23, 27-36, 43-49 under obviousness double patenting Applicants' arguments were found unpersuasive. In the co-pending application 09/802,162 the claims recite cDNA reagents and the instant claims reciting first component comprising RNA having a capture sequence and a target sequence which reads on mRNA and the cDNA reagents in the claims of co-pending application do not exclude mRNA as a

component of cDNA reagents. Accordingly the recitation of RNA as claimed in the instant claims are within the scope of the claims in the co-pending application and the rejection is maintained.

Conclusion

No claims are allowable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Suryaprabha Chunduru/

Primary Examiner, Art Unit 1637